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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/654,824

09/04/2003

Harry E. Smith

RAIL

5171

20441

7590

07/11/2005

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EXAMINER

HARTMANN, GARY S

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/654,824

Applicant(s)

SMITH, HARRY E.

Examiner

Gary Hartmann

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 13 and 15-25 is/are pending in the application.  
 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-9, 11 and 13 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
     1. ☐ Certified copies of the priority documents have been received.  
     2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_  
 4) ☐ Interview Summary (PTO-413)  
     Paper No(s)/Mail Date \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 15-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims recite limitations not presented in the originally filed claims. While the invention of the originally presented claims may be used with the invention of the newly submitted claims, the originally presented invention is also separately useable, since it may be configured in a manner patentably distinct from that as recited in the newly submitted claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno (Japanese Patent 2001-34214).

Mizuno discloses an electronic display mounted in a concave section of a guard rail (Figure 8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent 6,107,941) in view of Attwood et al. (U.S. Patent 3,468,567).

Jones teaches an electronic display, but it is not mounted on a guard rail. Attwood et al. teaches mounting signs similar to Jones to a guardrail (Figure 4, for example). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have mounted the device of Jones to a guard rail, as taught by Attwood et al., in order to convey information to a vehicle adjacent the guard rail, as is well known.

Jones teaches a message display (Figure 1, for example), it is computer controllable and it is solar powered.

The apparatus of Attwood et al. is set a protective distance into the guard rail (Figure 4, for example) and the guard rail is a W type rail, thereby meeting recitations of claim 3.

Regarding claim 9, Jones discloses a transmitter (66) for sending information to the display. It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to have used the system as claimed in order to obtain an efficient information transmission system, in accordance with the teaching of Jones.

Regarding claim 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a voice recognition module with Jones in order to, for example, ease operation of the apparatus by a handicapped person.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrig (U.S. Patent 4,723,758) in view of Jones, as applied above.

Gehrig teaches positioning a display device into a concave section of a guard rail (Figure 3, for example), but the display device is not electronic. It is well known to use electronic display devices in conjunction with guardrails, as taught by Jones. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an electronic device with the guard rail of Gehrig in order to convey desired information, in accordance with the teaching of Jones.

### ***Response to Arguments***

Applicant's arguments filed April 26, 2005 have been fully considered but they are not persuasive. The arguments with respect to claim 1 are far more specific than is the claim language. The claim recites only an electronic device mounted on a guard rail. These limitations are met as discussed in the rejections above. All other discussion with respect to claim 1 is moot as the specifics are not recited.

Arguments with respect to other claims are similarly directed to either limitations not present in the claims and/or pointing out deficiencies in the prior art when that prior art was not

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applied in the manner being discussed. For example, applicant discusses that Jones is not embedded in a guard rail; yet nowhere in the rejection is Jones used as a teaching of embedding a device into a guard rail. To the contrary, it has been specifically stated in the rejection that Jones is not taught to be attached to a guard rail. Arguments regarding other claims and references are similarly misdirected.

Regarding the amended range in claim 7, note that the term "about" denotes that the range is not absolutely within the 2 to 22 degrees. Zero is deemed to be within the scope of this limitation, particularly in light of the specification.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

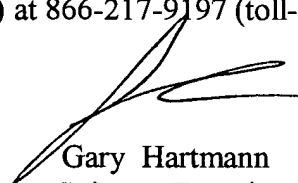
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Monday through Thursday, 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Gary Hartmann  
Primary Examiner  
Art Unit 3671